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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,067	01/19/2001	John D. Graham	GTC 0005-US	8300
23719 7590 02/04/2008 KALOW & SPRINGUT LLP 488 MADISON AVENUE 19TH FLOOR NEW YORK, NY 10022			EXAMINER TRAN, QUOC A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

mn

Office Action Summary	Application No.		Applicant(s)	
	09/766,067		GRAHAM ET AL.	
	Examiner		Art Unit	
	Tran A. Quoc		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25,28-37,39-76 and 78-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25,28-37,39-76 and 78-88 is/are rejected.
- 7) ☒ Claim(s) 1, 40, 81 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's Response

In Applicant's Response dated 11/13/2007, Applicant amended Claims 1, 2, 6-7, 12-24, 28-36, 40-41, 45-46, 51-71, 79-81 and 85-88, cancelled Claims 26-27, 38, 77 and argued against all objections and rejections previously set forth in the Office Action dated 005/09/2007. It is note the Applicant's amendment to the Specification is accepted -see Page 6, Line 3, and Page 7, Line 29 of Applicant disclosure.

Based on Applicant's amendments, the claim(s) objection and 112 second paragraph is withdrawn.

Claim Objections

Claim 40 is objected to because of the following informalities:

- The claim recites a "system" (see Line 1), yet recites "method" steps (e.g., "reviewing second content" in Line 8 and "linking the first content with the second content" in Lines 10-11). Applicant must either:
 1. amend the claim to recite a "method" and delete the recited hardware components of the "system" (i.e., "workstation" in Line 2 and "server" in Line 5) from the claim language; or
 2. amend the claim to specifically recite and indicate which components of the "system" perform the recited functions (i.e., the "method" steps indicated above).

Additionally, the claim should be reformatted so that the elements in the body of the claim are recited in separate paragraphs. See 37 C.F.R. 1.75(i) and MPEP 608.01(m).

Claim 81 is objected to because of the following informalities:

- The claim recites a “*system*” (see Line 1), yet recites only “method” steps (see each of the elements recited in the body of the claim). Applicant must either:
 1. amend the claim to recite a “method;” or
 2. amend the claim to specifically recite and indicate which components of the “system” perform the recited functions.

Additionally, the claim should be reformatted so that the elements in the body of the claim are recited in separate paragraphs. See 37 C.F.R. 1.75(i) and MPEP 608.01(m).

Claims 1 and 88 are objected to because of the following informalities:

- The claims should be reformatted so that the elements in the body of each claim are recited in separate paragraphs. See 37 C.F.R. 1.75(i) and MPEP 608.01(m).

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-25, 28-37, 39-76, and 78-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over by **Schmidt** et al., U.S. Patent No. 6,418,457 filed 12/10/1997 (hereinafter, "Schmidt"), in view of **Frank** et al., U.S. Patent No. 7,127,405 Provisional No. 60/173,919 filed 12/30/1999 (hereinafter, "Frank").

Claim 1:

Schmidt discloses *a method for tracking content and creating new intellectual property comprising* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system is an electronic replacement for the traditional inventor's notebook. The system comprises a notebook database that stores documents created by inventors and a patent database that allows attorneys to access the documents and use the documents to write patent applications.):

- *receiving an entry of first content relating to a first piece intellectual property from a first user* (see Schmidt Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows a first inventor to create

and save a first document relating to a first portion of a project. The system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project.);

- *storing the first content relating to a first peace of intellectual property with a time stamp and an identifier of the first user (see Schmidt Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows the inventors to store the documents that they have created. For each saved document, at the time the document is saved into the system, the system stores the inventor's name and time stamps the document.);*
- *Wherein the first peace of intellectual property relates to at least one first idea, invention, patent, trademark, trade secret or copyright (see Schmidt Column 2, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows the inventors to store the documents that they have created. For each saved document, at the time the document is saved into the system, the system stores the inventor's name and time stamps the document (i.e. stored document is the notebook database, set up with divisions for Disclosures, Applications, Patents, and Abandoned invention data, this patent database provides electronic search and retrieval of data by various means, e.g. inventor's name; disclosure, application, or patent number; title; keywords; content; date,)*
- *preventing any changes to the first content, the time stamp, and the identifier after the first content, the time stamp, and the identifier have been stored (see*

Schmidt Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system permits no alteration of the documents after the documents are time stamped),

In addition Schmidt does not expressly teach, but Frank teaches:

- *reviewing second content relating to a second piece of intellectual property from a second user, wherein the second piece of intellectual property relates to at least one second idea, invention, patent, trademark, trade secret or copyright;* (see Column 4 Line 60 → Column 5 Line 15, Column 87, Lines 30-45→ Frank discloses methods and systems to manage the development and marketing (e.g., licensing, sale, leveraging, etc.) of various assets. Examples of intellectual property assets (i.e., intellectual property units) include, for example, inventions, ideas, patents, trademarks, service marks, copyrights, trade secrets, data, computer code and software. IP life cycle can comprises plurality of stages includes identify and develop Intellectual property comprises steps in managing the life cycle of the intellectual property; such as literately revised the Intellectual property. Frank further discloses at Column 95, Line 55→ Column 96, Line 55 and Table 3, there are multiple inventors that working on different versions (i.e. *second content*) of the same idea (i.e. first content and/or idea); this interpretation is supported by the Applicant's disclosure, which is states, "*Content in an IP element may also include one or more other IP elements. Thus, when an existing idea is stored in an existing IP element, that idea may be combined with*

a new idea by storing the new idea as a document and linking to the existing IP element within the content of a new IP element'- See the Applicant's Specification Page 6, Lines 5-29.)

- *linking the first content with the second content and combining each of the pieces of intellectual property from each of the users to create new intellectual property, wherein the new intellectual property is at least one new idea, invention, patent, trademark, trade secret, or copyright* (see Column 95, Line 55→ Column 96, Line 55 and Table 3 →Frank discloses the IP may be identified by a team of IP miners through an IP audit for modifications and improvements to the IP asset may also be identified in view of the potential marketing opportunities. Frank further discloses at Column 95, Line 55→ Column 96, Line 55 and Table 3, there are multiple inventors those workings on different versions (i.e. *second content*) of the same idea (i.e. first content and/or idea). It is noted that Frank further discloses the user can input a variety of information into utilization assessment system 7200. The information input is related to the IP assets, including valuation information, competitive product information, patent information, customer information, infringement information. The user may also link to internal databases. Internal databases may include information related to, among other items, (i.e. liking contents).)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Schmidt teaching, provides a method for tracking

content and creating new intellectual property, to include a means of reviewing second content relating to a second piece of intellectual property from a second user, wherein the second piece of intellectual property relates to at least one second idea, invention, patent, trademark, trade secret or copyright; linking the first content with the second content and combining each of the pieces of intellectual property from each of the users to create new intellectual property, wherein the new intellectual property is at least one new idea, invention, patent, trademark, trade secret, or copyright as taught by Frank. One of ordinary skill in the art would have been motivated to modify this combination, to archive a predictable resulted of said enables inventors to adequately disclose intellectual property asset selection and protection- See Frank at Column 2, Lines 25-40, and the system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project see Schmidt Column 1, Line 1 through Column 10, Line 19.)

Claim 2:

Schmidt discloses *the method of Claim 1, further comprising:*

- *presenting a user interface to each of the users through which content relating to the peace of intellectual property may be received* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system operates on a computer network and provides user interfaces that allow

inventors to create the documents relating to the project and allow other various users to access the documents) *and*

- *crediting each of the users with their contribution to the new intellectual property* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that, for each saved document, the system stores the inventor's name. Thereafter, when attorneys create patent applications using the documents, each inventor is credited with their contribution to the invention.).

Claim 3:

Schmidt does not expressly teach, but Frank teaches:

- *wherein the user interface is a Web page* (see Column 22, Lines 5-10 → Frank discloses this limitation in that the system operates on a patent protection system 5000 may be configured so that it can receive patent information from one or more websites.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Schmidt teaching, to include the user interface is a Web page as taught by Frank. One of ordinary skill in the art would have been motivated to modify this combination, to achieve a predictable result of said enables inventors to adequately disclose intellectual property asset selection and protection- See Frank at Column 2, Lines 25-40, and the system also allows multiple inventors who are working on other portions of the same project to create and save documents relating

to their corresponding portions of the project see Schmidt Column 1, Line 1 through Column 10, Line 19.)

Claim 4:

Schmidt discloses *the method of Claim 2, wherein the user interface is an email client received* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to access the documents via email).

Claim 5:

Schmidt discloses *the method of Claim 2, wherein the user interface is presented in a page paradigm* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows inventors to create the documents using a “notebook” interface).

Claim 6:

Schmidt does not expressly teach, but Frank teaches:

- *designating the first or second content relating to the first and second pieces of the intellectual property as having a value to the corresponding user* (see Column 95, Line 55 → Column 96, Line 55 and Table 3, Frank discloses this limitation in that, there are multiple inventors those workings on different versions (i.e. *second content*) of the same idea (i.e. first content and/or idea). It is noted that Frank further discloses the user can input a variety of information into utilization

assessment system 7200. The information input is related to the IP assets, including valuation information, competitive product information, patent information, customer information, infringement information. The user may also link to internal databases. Internal databases may include information related to, among other items, (i.e. liking contents).)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Schmidt teaching, provides a method for tracking content and creating new intellectual property, to include a means of designating the first or second content relating to the first and second pieces of the intellectual property as having a value to the corresponding user as taught by Frank. One of ordinary skill in the art would have been motivated to modify this combination, to archive a predictable resulted of said enables inventors to adequately disclose intellectual property asset selection and protection- See Frank at Column 2, Lines 25-40, and the system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project see Schmidt Column 1, Line 1 through Column 10, Line 19.)

Claim 7:

Schmidt does not expressly teach, but Frank teaches:

- *tracking a value associated with the first or content relating to the first and second peaces of intellectual property (see Column 95, Line 55→ Column 96, Line 55 and Table 3, Frank discloses this limitation in that, there are multiple*

inventors those workings on different versions (i.e. *second content*) of the same idea (i.e. first content and/or idea). It is noted that Frank further discloses the user can input a variety of information into utilization assessment system 7200. The information input is related to the IP assets, including valuation information, competitive product information, patent information, customer information, infringement information. The user may also link to internal databases. Internal databases may include information related to, among other items, (i.e. liking contents).)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Schmidt teaching, provides a method for tracking content and creating new intellectual property, to include a means of tracking a value associated with the first or second piece-of content relating to the first and second pieces of intellectual property as taught by Frank. One of ordinary skill in the art would have been motivated to modify this combination, to archive a predictable result of said enables inventors to adequately disclose intellectual property asset selection and protection- See Frank at Column 2, Lines 25-40, and the system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project see Schmidt Column 1, Line 1 through Column 10, Line 19.)

Claims 8-11:

Schmidt does not expressly teach, but Frank teaches:

- *wherein the value is estimate value, market value, compound value, and proportion value* (see Column 2, Lines 1-4 , Frank discloses this limitation in that market the intellectual property assets, are foregoing significant value that could otherwise be generated from licensing selling, trading, or donating such assets.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Schmidt teaching, provides a method for tracking content and creating new intellectual property, to include a means of tracking a value wherein the value is estimate value, market value, compound value, and proportion value as taught by Frank. One of ordinary skill in the art would have been motivated to modify this combination, to archive a predictable resulted of said enables inventors to adequately disclose intellectual property asset selection and protection- See Frank at Column 2, Lines 25-40, and the system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project see Schmidt Column 1, Line 1 through Column 10, Line 19.)

Claim 12:

Schmidt discloses *the method of Claim 1, further comprising:*

- *tracking the owner of the first or second content* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores the inventor's name for each saved document).

Claim 13:

Schmidt does not expressly teach, but Frank teaches:

- *providing information relating to the first or second content to a trading system*

(see Column 2, Lines 1-4 , Frank discloses this limitation in that market the intellectual property assets, are foregoing significant value that could otherwise be generated from licensing selling, trading, or donating such assets.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Schmidt teaching, provides a method for tracking content and creating new intellectual property, to include a means of said providing information relating to the first or second content to a trading system as taught by Frank. One of ordinary skill in the art would have been motivated to modify this combination, to archive a predictable resulted of said enables inventors to adequately disclose intellectual property asset selection and protection- See Frank at Column 2, Lines 25-40, and the system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project see Schmidt Column 1, Line 1 through Column 10, Line 19.)

Claim 14:

Schmidt discloses *the method of Claim 1, further comprising:*

- *providing information relating to the first or second content to a docketing system*

(see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this

limitation in that the system stores the documents created by the inventors in the databases).

Claim 15:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining metadata relating to the first or second piece of content to a docketing system* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores data relating to the documents created by the inventors in the databases).

Claim 16:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining log data relating to the first or second content* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system designates the status of documents that are filed as patent applications).

Claim 17:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining context information relating to the first or second content* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various

projects together as a group and displays to users only those documents in groups to which the users belong).

Claim 18:

Schmidt discloses *the method of Claim 17, wherein the context information identifies a collaborative relationship between the first and second users* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and displays to users only those documents in groups to which the users belong)..

Claim 19:

Schmidt discloses *the method of Claim 18, wherein the collaborative relationship is a joint project of the first and second users* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and displays to users only those documents in groups to which the users belong).

Claim 20:

Schmidt discloses *the method of Claim 18, further comprising:*

- *controlling access to the first or second content by the first and second users* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with the various

projects together as a group and displays to users only those documents in groups to which the users belong).

Claim 21:

Schmidt discloses *the method of Claim 1, further comprising:*

- *maintaining information relating to the first or second user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores the inventor's name for each saved document and allows users to access only those documents in groups to which the users belong).

Claim 22:

Schmidt discloses *the method of Claim 21, wherein the information includes personal information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system stores the inventor's name for each saved document).

Claim 23:

Schmidt discloses *the method of Claim 21, wherein the information includes employment information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system, for each saved document, stores the inventor's name, the subject of the document and the project of the document).

Claim 24:

Schmidt discloses *the method of Claim 21, wherein the information includes functional role information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system, for each employee involved in a project, stores the employee's role in the project).

Claim 25:

Schmidt discloses *the method of Claim 24, further comprising: controlling access to the first or second content based upon the functional role information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system, based upon the employee's role in the project, controls the employee's access to the documents within the project).

Claim 28:

Schmidt discloses *the method of Claim 1, further comprising:*

- *enabling the first or second content to be linked to a file* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group).

Claim 29:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first or second piece of content, the time stamp, and the identifier of the user with a draft status* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system includes a “disclosure” section and an “application” section within the patent database).

Claim 30:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first content, the time stamp, and the identifier of the user with a registered status* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system includes a “patent” section within the patent database).

Claim 31:

Schmidt discloses *the method of Claim 1, further comprising:*

- *linking the first or second piece of content, the time stamp, and the identifier to other information* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group. The documents comprise witness statements and communications with attorneys regarding the creation and filing of patent applications based on the documents.).

Claim 32:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing with the first or second content, the time stamp, and the identifier recovery information identifying the other information (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and allows users to recover those documents).*

Claim 33:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first or second content, the time stamp, and the identifier in a permanent form (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system permits no alteration of the documents and the associated information relating to the documents after the documents are stored).*

Claim 34:

Schmidt discloses *the method of Claim 1, further comprising:*

- *storing the first or second content, the time stamp, and the identifier in a manner that permits the content to be admissible as evidence (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows documents to be certified by Public Notaries).*

Claim 35:

- Schmidt discloses *the method of Claim 34, wherein the first or second content, the time stamp, and the identifier are stored such that the first or second content, the time stamp, and the identifier cannot be separated* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves all documents associated with each of the various projects together as a group and permits no alteration or movement of the documents after the documents are stored).

Claim 36:

Schmidt discloses *the method of Claim 1, further comprising:*

- *submitting the first or second piece of content, the time stamp, and the identifier to a witness* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to attach witness statements to the documents).

Claim 37:

- Schmidt discloses *the method of Claim 36, wherein the witness is a third party* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to attach witness statements to the documents and allows documents to be certified by Public Notaries).

Claim 39:

- Schmidt discloses *the method of Claim 1, further comprising generating a digital fingerprint for the first or second content, the time stamp, and the identifier, and storing the digital fingerprint* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system allows witnesses to attach witness statements to the documents and allows documents to be certified by Public Notaries, also see Schmidt at the Abstract → a document creator to enable the inventor to describe his invention in a document, a document saver that stores the document with a digital signature of the inventor and a time stamp. The saver prevents any further modification of the document except an addition of: a witness statement, a digital signature, and a time stamp.)

Claims 40-64, 67-76, and 78:

Claims 40-64, 67-76, and 78 merely recite a system for performing the method recited in Claims 1-25 and 28-37, respectively. Thus, Schmidt and Frank disclose every limitation of Claims 40-64, 67-76, and 78 and provide proper reasons to combine, as indicated in the above rejections for Claims 1-25 and 28-37.

Claim 65:

Schmidt discloses *the system of Claim 40, wherein the server also enables the first or second content to be linked to another content that is already stored is a process* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation

in that the system comprises a computer network including nodes and servers that saves all documents associated with each of the various projects together as a group).

Claim 66:

Schmidt discloses *the system of Claim 65, wherein the other content was created by another user* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation in that the system saves documents, created by multiple users and associated with one project, together as a group).

Claim 79:

Schmidt discloses *the method of Claim 1, wherein the first or second piece of intellectual property is at least one, patent, trademark or copyright* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation, as clearly indicated in the cited text).

Claim 80:

Schmidt discloses *the method of Claim 1, wherein the new intellectual property is at least one, patent, trademark or copyright* (see Column 1, Line 1 through Column 10, Line 19 → Schmidt discloses this limitation, as clearly indicated in the cited text).

Claims 81- 86:

Claims 81-86 recite a system for performing the method recited in Claims 1, 2, 7-11. Thus, Schmidt and Frank disclose every limitation of Claims 81-86 and provide proper reasons to combine, as indicated in the above rejections for Claims 1-1, 2, 7-11.

Claim 87:

Schmidt does not expressly teach, but Frank teaches:

- wherein the system further comprises a custodian workstation allowing a custodian to verifying the integrity of information contained in the system and an administrator workstation which allows the administrator to oversee each user of the system (see Column 39 Line 55 --> Column 40 Line 67 → Frank discloses this limitation in that the system includes intellectual property management system to create and track data records and provides GUI components illustrated in FIGS. 50 through 165 shows interfaces that can be presented to a user to facilitate the efficient monitoring and creation of intellectual property marketing information system).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Schmidt teaching, provides a method for tracking content and creating new intellectual property, to include a custodian workstation allowing a custodian to verifying the integrity of information contained in the system and an administrator workstation which allows the administrator to oversee each user of the system as taught by Frank. One of ordinary skill in the art would have been motivated to

modify this combination, to archive a predictable resulted of said enables inventors to adequately disclose intellectual property asset selection and protection- See Frank at Column 2, Lines 25-40, and the system also allows multiple inventors who are working on other portions of the same project to create and save documents relating to their corresponding portions of the project see Schmidt Column 1, Line 1 through Column 10, Line 19.)

Claim 88:

Claim 88 corresponds to Claims 6 and 7. Thus, Schmidt, in view of Frank, discloses/teaches every limitation of Claim 88 and provides proper reasons to combine, as indicated in the above rejections for Claims 6 and 7.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number:
09/766,067
Art Unit: 2176

Page 27

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01/27/2008

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